

REMARKS

Claims 1-26 are pending. Of those, claims 1, 9, 15, 21, 23 and 25 are independent.

On page 8 of the Office Action, the Examiner has indicated that dependent claims 4, 5, 12, 13, 18, 19, 22, 24 and 26 recite allowable subject matter, for which Applicants are appreciative.

Applicants thank the Examiner for the cooperation extended in the form of the telephonic interview conducted on March 31, 2005 with the undersigned. Authority, or the lack thereof, for the position taken in the §101 rejection was discussed. Also, the term of art, "function prototype," was discussed in the context of the §102(e) rejection.

§101 Rejection

On page 2 of the Office Action, claims 9-14 and 23-24 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. More specifically, the Examiner notes that the "preamble needs to recite a *computer* readable medium containing *computer* readable instructions ..." (*italicized emphasis in original*). Applicants traverse.

Currently, e.g., claim 9 recites (underlined emphasis added): " A machine readable medium having recorded thereon machine readable instructions, execution of which by a machine facilitates ...". Applicants acknowledge that couching claim 9 in terms of a machine as opposed to a computer achieves a broader scope. Nevertheless, the Examiner's requirement of changing the phraseology from machine-based phraseology to computer-based phraseology, in the context of statutory subject matter under §101, pursues a distinction without a difference.

Moreover, what authority supports the Examiner's position? Specifically, what authority deems computer-based phraseology as statutory and machine-based phraseology

non-statutory? No such authority is believed to exist. Applicants challenge the Examiner to produce such authority.

Without such authority, the Examiner's position is improper. Withdrawal of the §101 is requested.

§102 Rejections

Beginning on page 3 of the Office Action, claims 1-3, 6-11, 14-17 and 20-21, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. pre-grant publication ("PGPub") No. 2003/0046606 to Johnson et al. (the '606 PGPub). Applicants traverse.

Previously, Applicants noted a distinction of claims 1, 9 and 15 over the '606 PGPub, namely generating a dynamically loadable kernel module (DLKM) based upon function prototypes corresponding to the interface functions of the service to be tested. In the interview noted above, the Examiner indicated that he had not recognized the phrase "function prototypes" as a term of art, and consequently had not attributed the meaning to that phrase that one of ordinary skill would have. Independent claims 21, 23 and 25 recite features similar to that of claims 1, 9 and 5, respectively, noted above.

In some respects, a function prototype is akin to comments inserted into program code. Such comments are provided to enhance a reader's understanding of source code and are listed within the source code in such a way that the computer does not act upon the text as if it were program code. Analogously, function prototypes can be provided to enhance a compiler's understanding of functions that can be recited in the source code and are listed in such a way that the compiler does not treat the function prototype as an instance of the function.

For the Examiner's convenience, Applicants are supplying evidence that the phrase "function prototypes" is a term of art. Function prototypes can reduce the problems associated with a program code author who tries to use a function with incorrect arguments.^{1]} Function prototypes are optional aspects of program code.^{2]} Function prototypes resolve the problem that, but for the function prototypes, a function could only call a function that precedes it in the program code.^{3]} For example, a function prototype can identify the name of the function, the type of data returned by the function, the number of parameters the function expects to receive, the types of parameters the function expects to receive, the order in which the parameters are expected to be received, etc.^{4]} Also for the Examiner's convenience, Applicants have enclosed a form PTO-1449 listing the evidence and request the Examiner to make the evidence of record.

Applicants acknowledge that the '606 PGPub literally discloses "a module adapted to be dynamically loaded to a kernel of an operating system," at paragraph [0009] (cited by the Examiner). Further, it is acknowledged that the '606 PGPub literally discloses that "the module functions as a pseudo driver that is loadable to the kernel subsequent to initialization." See paragraph [0023].

The '606 PGPub is silent, however, about how module 20 is generated. Rather, there is an assumption that somehow module 20 gets generated before the time at which it is to be loaded. But generating such a module is different than loading such a module.

Under U.S. patent law⁵, an aspect not literally disclosed by a reference is considered to be inherently present if the difference between what is literally disclosed and what is claimed necessarily flows from the literal disclosure. Here, the '606 PGPub is silent as to

¹ See, e.g., <http://www.nmr.mgh.harvard.edu/C/prototypes.shtml>.

² See, e.g., <http://www.eskimo.com/~scs/cclass/notes/sx5b.html>.

³ See, e.g., <http://www.taumoda.com/web/class/day7.html>.

⁴ See, e.g., <http://www.codeproject.com/Purgatory/blackozemia.asp>

⁵ For example, see the Manual of Patent Examining Procedure, Section 2112 in general, and particularly the subsection entitled "Examiner Must Provide Rationale Tending To Show Inherency".

how module 20 is generated. The only thing that necessarily flows from the literal disclosure of the '606 PGPub regarding generation of module 20 is that it must somehow have been generated by virtue of it existing. Beyond that, it is unreasonable to assert that the claimed generation of a dynamically loadable kernel module (DLKM) based upon function prototypes (corresponding to interface functions of a kernel-space service that is to be tested) necessarily flows from the literal disclosure of the '606 PGPub.

Claims 2-3, 6-8, 10-11, 14, 16-17 and 20 depend at least indirectly from claims 1, 19 and 15, respectively, and so correspondingly exhibit at least the respective distinctions.

In view of the foregoing discussion, withdrawal of the §102(e) rejection over the '606 PGPub is requested.

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CONCLUSION

The issues in the case are considered to be resolved. Accordingly, Applicants request a Notice of Allowability.


If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-0750, including, in particular, extension of time fees.

Respectfully submitted,

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